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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,997	03/08/2001	John W. Torget	47004.000107	6654

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EXAMINER
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ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/800,997

Applicant(s)

TORGET ET AL.

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 69-72 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

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### **DETAILED ACTION**

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- Claims 1-5, 7, 8, 16-24, 28 and 66 are amended.
- Claims 29-65 and 67-68 are canceled.
- Claims 69-72 are added
- Claims 1-28, 66 and 69-72 have been considered.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 August 2005 has been entered.

### ***Response to Arguments***

3. Applicant's arguments filed 18 August 2005 have been fully considered but they are not persuasive for the following reasons:

4. In response to applicant argument regarding rejection of claims 1, 18 and 66 in particular under 35 U.S.C. § 102 as being anticipated by Yamaguchi.

As per the argument put forward by the applicant regarding claims 1, 18 and 66, examiner would like to bring the attention of the applicant to paragraph [0087] in particular as the Yamaguchi reference clearly teaches a visible image is used for over lay that is visible on the instrument as printed as well as the instrument has invisible data hidden within barcodes as well as the visible watermark printed on the instrument (See Yamaguchi figures 2-5, 9, 22, and 23 and related text). The thrust of the applicants argument is that the first security image is visible on the instrument printed on the medium. Yamaguchi clearly teaches the printing of the visible and invisible image data as to be printed on a medium (See

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Yamaguchi paragraphs [0034]-[0036]). Further, it is clearly stated that the logo mark is used as a visible as well as invisible state as to be used as a security image.

As per arguments presented by the applicant for claims 2-17 and 19-27, the arguments by the applicant all reference to the same issue, as the first security image is visible, which is addressed by the above argument. Therefore the rejection of claims as presented below stand and claims 1-28 and 66 are rejected.

***Election/Restriction***

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-28 and 66 are drawn to a method and system for generation of printable certified electronic financial instruments, which include digital watermark for security and verification classified in class 705 subclass 33.
  - II. Claims 29-65 and 67 are drawn to a method and system for distribution and verification of a printable certified electronic financial instrument containing digital watermarks for security and verifying the authenticity of the printed instrument classified in class 283 subclass 72.
  - III. Claim 68 is drawn to a printer apparatus capable of printing composite images classified in class 358 subclass 450.
5. Inventions I, II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case printing other processed images or text.
6. The inventions are distinct, each from the other because of the following reasons:
7. Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as generating a verifiable instrument. Invention II

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has separate utility such as generating a verifiable instrument and verifying such printed instrument.

Invention III has separate utility such as printing composite images, which could be verifiable instruments as well. See MPEP § 806.05(d).

8. Inventions III and I are not related. In the instance case, invention I, method and system, has separate utility such as generating a verifiable instrument. Invention III, apparatus, has separate utility such as printing composite images, which could be verifiable instruments as well.

9. Invention II and III are not related. In the instance case, invention II, method and system, has separate utility such as generating a verifiable instrument and verifying such printed instrument. Invention III, apparatus, has separate utility such as printing composite images, which could be verifiable instruments as well. See MPEP 806.05(d).

10. Newly submitted claims 69-72 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

11. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

Accordingly, claims 69-72 are withdrawn from consideration as being directed to a non-elected invention.

See 37 CFR 1.142(b) and MPEP 821.03. Applicant is respectfully requested to cancel the non-elected claims in response to this office action.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

13. Claims 1-3, 10-11, 15-16, 18-20, 25, 27, and 66 are rejected under 35 U.S.C. 102(a) as being anticipated by European Patent Application No. EP 1-014-318 A2 to Takashi Yamaguchi.

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14. As per claims 1, 18 and 66, Yamaguchi discloses a system its method and electronically readable medium for remotely generating an instrument, comprising:

- a) a processor that receives from a customer a request for the instrument (See Yamaguchi abstract, figures 2 step S8, and paragraph [0010] and [0023]);
- b) generates the instrument in electronic form (See Yamaguchi abstract, figures 2 step S11, and paragraph [0010]-[0013] and [0025]);
- c) adds a first security image in electronic form to the electronic form of the instrument to create a composite image (See Yamaguchi abstract, figures 2 step S12, and paragraph [0010]-[0013] and [0025]); and
- d) a communications module that transmits the composite image in electronic form to the customer for printing by the customer (See Yamaguchi abstract, figures 2 step S12, and paragraph [0010]-[0013] and [0025]-[0026], where transmits corresponds to sent).

Wherein the first security image is visible on the instrument printed on the medium (See Yamaguchi figures 2-5, 9, 22, and 23 and related text, paragraphs [0034]-[0036] and [0087]).

15. As per claims 2 and 19, Yamaguchi discloses all the limitations of claims 1 and 18, wherein the first security image comprises a watermark (See Yamaguchi figures 3-8, paragraphs [0034], [0044], [0049]-[0050] and [0062], where watermark corresponds to data to be embedded in the image data in the invisible state).

16. As per claim 3 and 20, Yamaguchi discloses all the limitations of claims 2 and 19, wherein the first security image is invisible on a photocopy of the instrument printed on a medium (See Yamaguchi abstract, figures 2 step S12, and paragraph [0010]-[0013], [0034]-[0035, and [0084]-[0087]).

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17. As per claim 10, Yamaguchi discloses all the limitations of claim 1, wherein the instrument comprises a monetary instrument (See Yamaguchi figure 23, paragraph [0092], where monetary instrument corresponds to enable a user issue what has a value equal to money).

18. As per claim 11, Yamaguchi discloses all the limitations of claim 10, wherein the instrument represents certified funds (See Yamaguchi figure 23, paragraph [0092], where monetary instrument corresponds to enable a user issue what has a value equal to money like postage stamps. Stamps are certified funds used for variety of transactions and fee payments especially in official correspondents).

19. As per claim 15, Yamaguchi discloses all the limitations of claim 10, wherein the request comprises at least one of an amount, a denomination and a currency of the monetary instrument (See Yamaguchi figure 3, and paragraphs [0010]-[0013] [0023] and [0031]).

20. As per claims 16 and 27, Yamaguchi discloses all the limitations of claims 1 and 18, further comprising a step of e) associating a unique identification number with the instrument (See Yamaguchi figure 3, and paragraphs [0010]-[0013] [0023], [0031] and [0035]).

21. As per claim 25, Yamaguchi discloses all the limitations of claim 18, wherein the instrument comprises a monetary instrument that represents certified funds (See Yamaguchi figure 23, paragraph [0092], where monetary instrument corresponds to issue what has a value equal to money) and the instrument represents certified funds (See Yamaguchi figure 23, paragraph [0092], where monetary instrument corresponds to enable a user issue what has a value equal to money like postage stamps. Stamps are certified funds used for variety of transactions and fee payments especially in official correspondents).

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22. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

***Claim Rejections - 35 USC § 103***

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 4-9, 12-13, 17, 21-24, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application Publication No. EP 1-014-318 A2 to Takashi Yamaguchi in view of U.S. Patent No. 6,390,362 to David A. Martin.

25. As per claim 4-6 and 21-22, Yamaguchi discloses all the limitations of claims 3 and 20, further;

What Yamaguchi is not explicit is the composite image is for printing on a medium having a second security image, the second security image is invisible on the instrument and is visible on a photocopy of the instrument, the second security image comprises the word "void".

However, Martin clearly discloses the presence of secondary security image on the instrument visible only when the instrument has been copied and displaying the word "Void" (See Martin column 2, lines 11-15 and 21-24 and column 4, lines 21-39).



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Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to further include additional security images such as pantographs spelling out certain words or images (Void or Copy, etc.) for the motivation of better security and fraud prevention.

26. As per claim 7-9 and 23-24, Yamaguchi discloses all the limitations of claims 1 and 18, further;

What Yamaguchi is not explicit is the medium comprises a second security image, the second security image is invisible on the instrument printed on the medium and is visible on a photocopy of the instrument printed on the medium, the second security image comprises the word "void".

However, Martin clearly discloses the presence of secondary security image on the instrument visible only when the instrument has been copied and displaying the word "Void" (See Martin column 2, lines 11-15 and 21-24 and column 4, lines 21-39).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to further include additional security images such as pantographs spelling out certain words or images (Void or Copy, etc.) for the motivation of better security and fraud prevention.

27. As per claims 12, Yamaguchi discloses all the limitations of claim 11, further;

What Yamaguchi is not explicit and specific is the instrument is generated by an issuing financial institution, the funds are certified by the issuing financial institution and the customer holds a deposit account with the issuing financial institution.

However, Martin clearly discloses that a financial entity such as a bank is the generator of the instrument and the bank is grantor of the payment of the face amount to the payee from the payer's account held at the bank (See Martin abstract, column 3, line 55-column 4, line 2 and column 8, lines 10-19).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to have the financial institution certify the financial instrument created and

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drawn on an account of an account holder and printed for the motivation of further security of the financial or negotiable instrument and presence of the funds to cover such instrument.

28. As per claim 13, Yamaguchi discloses all the limitations of claim 12, further;

What Yamaguchi is not explicit and specific is the funds are withdrawn from the customer's deposit account.

However, Martin clearly discloses that the funds are withdrawn from the customer's deposit account. (See Martin abstract, column 3, line 55-column 4, line 2 and column 8, lines 10-19).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to have the financial institution withdraw the funds from the account of the account holder for the motivation of further security of the financial or negotiable instrument and presence of the funds to cover such instrument.

29. As per claim 26, Yamaguchi discloses all the limitations of claim 25,

What Yamaguchi is not explicit and specific is the instrument is generated by an issuing financial institution, the funds are certified by the issuing financial institution and the customer holds a deposit account with the issuing financial institution.

However, Martin clearly discloses that a financial entity such as a bank is the generator of the instrument and the bank is grantor of the payment of the face amount to the payee from the payer's account held at the bank (See Martin abstract, column 3, line 55-column 4, line 2 and column 8, lines 10-19).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to have the financial institution certify the financial instrument created and drawn on an account of an account holder and printed for the motivation of further security of the financial or negotiable instrument and presence of the funds to cover such instrument.

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30. As per claims 17 and 28, Yamaguchi discloses a system and method that remotely generates an instrument representing certified funds, the system comprising;

- a) a processor that receives a request from a customer for an instrument (See Yamaguchi abstract, figures 2 step S8, and paragraph [0010] and [0023]),
- b) generates the instrument in electronic form (See Yamaguchi abstract, figures 2 step S11, and paragraph [0010]-[0013] and [0025]),
- c) adds a first security image in electronic form to the electronic form of the instrument to create a composite image (See Yamaguchi abstract, figures 2 step S12, and paragraph [0010]-[0013] and [0025]);
- d) a communications module that transmits the composite image in electronic form to the customer for printing by the customer on a medium (See Yamaguchi abstract, figures 2 step S12, and paragraph [0010]-[0013] and [0025]-[0026], where transmits corresponds to sent),
- e) wherein the first security image comprises a watermark wherein further the first security image is visible on the instrument printed on the medium, (See Yamaguchi figures 3-8, paragraphs [0034], [0044], [0049]-[0050] and [0062], where watermark corresponds to data to be embedded in the image data in the invisible state),
- f) wherein further the first security image is invisible on a photocopy of the instrument printed on the medium (See Yamaguchi abstract, figures 2 step S12, and paragraph [0010]-[0013] and [0034]),

What Yamaguchi is not explicit is the composite image is for printing on a medium having a second security image the second security image is invisible on the instrument and is visible on a photocopy of the instrument.

However, Martin clearly discloses the presence of secondary security image on the instrument visible only when the instrument has been copied (See Martin column 2, lines 11-15 and 21-24 and column 4, lines 21-39).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to further include additional security images such as pantographs spelling out certain words or images (Void or Copy, etc.) for the motivation of better security and fraud prevention.

What Yamaguchi is not explicit and specific is the instrument is generated by an issuing financial institution, the funds are certified by the issuing financial institution and the customer holds a deposit account with the issuing financial institution.

However, Martin clearly discloses that a financial entity such as a bank is the generator of the instrument and the bank is grantor of the payment of the face amount to the payee from the payer's account held at the bank (See Martin abstract, column 3, line 55-column 4, line 2 and column 8, lines 10-19).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to have the financial institution certify the financial instrument created and drawn on an account of an account holder and printed for the motivation of further security of the financial or negotiable instrument and presence of the funds to cover such instrument.

31. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application Publication No. EP 1-014-318 A2 to Takashi Yamaguchi in view of U.S. Patent No. 5,432,506 to Thomas R. Chapman.

32. As per claim 14, Yamaguchi discloses all the limitations of claim 10, further;

What Yamaguchi is not explicit and specific is the instrument comprises at least one of a stock certificate and a bond (See Yamaguchi figure 23, paragraph [0092], where monetary instrument corresponds to issue what has a value equal to money. As per disclosure of Dictionary of Finance and Investment Terms, fifth edition).

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However, Chapman clearly discloses that the an instrument can be checks, money orders, stock certificates, passports, other financial instruments, or other documents subject to counterfeiting and forgery (See Chapman abstract, column 1, lines 53-68, and column 4, lines 64-68).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to include other financial instruments as well as other documents subject to counterfeiting and forgery such as bonds and stock certificates for the motivation of further broadening of the usefulness of the Yamaguchi's invention.

33. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

### ***Conclusion***

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to **Kambiz Abdi** whose telephone number is **(571) 272-6702**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **(571) 272-6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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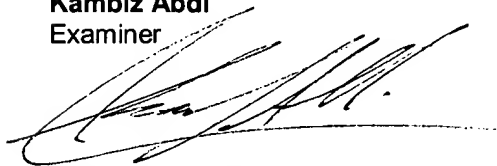
**(571) 273-8300** [Official communications; including After Final communications labeled "Box AF"]

**(571) 273-6702** [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the

**Knox Building, 50 Dulany St. Alexandria, VA.**

**Kambiz Abdi**  
Examiner

A handwritten signature in black ink, appearing to read 'Kambiz Abdi', written over a horizontal line.

**October 14, 2005**